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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,251	11/19/2001	Mitsuru Nakajima	1506.1014	8391

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EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/988,251

Applicant(s)

NAKAJIMA ET AL.

Examiner

Brian Goddard

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 January 2005 has been entered.

2. Claims 1-12 are pending in this application. Claims 1-3 and 6-12 are independent claims. In the Amendment filed 3 January 2005, claim 12 was added. This action is non-final.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,873,080 to Coden et al. in view of U.S. Patent No. 6,230,204 to Fleming, III (Hereinafter 'Fleming').

Referring to claim 1, Coden discloses an information search system as claimed. See Figures 1-7 and the corresponding portions of Coden's specification for this disclosure. Coden teaches an information search system [See Fig. 1 ] comprising:

an information storage unit [database 150] which stores a plurality of pieces of search target information [multimedia information 151];

a searching unit [Search Engines 162-166] which searches, when a user [125] specifies a search condition [query (See Figs. 4 & 6)], for a piece of search target information [multimedia information 151] satisfying the search condition from plural pieces of search target information in the information storage unit [in database 150];

a calculating unit [Combiner 170] which calculates [See step 740] a fitting value [rank value] indicating how much the search target information satisfies the search condition about the respective pieces of search target information searched by said searching unit in accordance with a fitting value calculation procedure [ranking algorithm] specified by the user [See column 12, lines 26-35 and column 9, line 54 - column 10, line 23]; and

a result-of-search presenting unit [See column 10, lines 57-59] which presents, to the user, at least a part of information that forms each piece of search target information searched by said searching unit [result list 380 (See step 760)] together with the fitting value [See column 10, lines 20-59 and column 12, lines 26-46] calculated by said calculating unit with respect to that piece of search target information.

Coden does not explicitly disclose the storage of personal information with respect to each of a plurality of users and information indicating that the pieces of

search target information are searched by the user, nor an outputting unit which outputs...the personal information on each user by whom the piece of search target information is searched as claimed.

Fleming discloses a search and retrieval system similar to that of Coden, wherein personal information [personal information and demographic information 920] with respect to each of a plurality of users [910] and a plurality of pieces of search target information [information resource(s) or resource(s) of interest] are stored in an information storage unit [121], information indicating that the pieces of search target information are searched by the user [See Figs. 3-7 & 9] are stored in the information storage unit, and the personal information on each user by whom the piece of search target information is searched when a piece of search target information is specified is output [See Figs. 9-10] as claimed. Fleming lists a number of reasons for using this tracking information for tracking the interest of users in certain resources in the Background of the Invention section (See columns 1-2). These include monitoring loads on system resources, charging usage fees, and collecting demographic information for advertisers so they can adjust their targeting of advertisements accordingly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Fleming's personal information storage and user interest tracking functionality to the system and method of Coden to obtain the invention as claimed. One would have been motivated to do so for the reasons provided by Fleming

as discussed above, in order to track the interest of users in the specific resources offered up by Coden's database.

Referring to claim 2, Coden v. Fleming discloses the information search system as claimed. See Figures 1-7 and the corresponding portions of Coden's specification for the details of this disclosure. Coden v. Fleming teaches "an information search system [See Fig. 1] comprising: an information storage unit [See claim 1 above]...; a calculating unit [See claim 1 above]...; an extracting unit [application of result viewing object (See step 720)] for extracting the search target information of which the fitting value calculated by said calculating unit satisfies a predetermined condition [condition(s) set by the user (See disclosure of combiner 170)], out of the plural pieces of search target information...[See claim 1 above]; a result-of-search presenting unit [See claim 1 above]...; and an outputting unit...[See claim 1 above]" as claimed.

Referring to claim 3, Coden v. Fleming discloses the information search system as claimed. See Figures 1-7 and the corresponding portions of Coden's specification for this disclosure. Coden v. Fleming teaches "an information search system [See Fig. 1] comprising:

an information storage unit which stores...[See claim 1 above]... search condition defining information [query specifications] for defining a search condition [query] with respect to each of the plurality of users [users 125], and fitting value calculation procedure defining information [rank algorithm definition] for defining a procedure for calculating a fitting value [rank value] indicating how much the information searched

under the search condition defined by the search condition defining information satisfies the search condition [See above];

a searching unit [See claim 1 above]... ;

a calculating unit [See claim 1 above]... ;

a result-of-search presenting unit [See claim 1 above]...; and

an outputting unit [See claim 1 above]..." as claimed.

Claim 4 is rejected on the same basis as claim 2, in light of the basis for claim 3 above. See the discussions regarding claims 1-3 for the details of this disclosure.

Referring to claim 5, Coden v. Fleming discloses the information search system as claimed. See Figures 1-7 and the corresponding portions of Coden's specification for this disclosure. Coden v. Fleming teaches the information search system according to claim 3, as above, wherein the plural pieces of search target information contain first type search target information [first media type (e.g. text)] permitted to be browsed [not restricted out by the result viewing object 350] by the one of the users, and second type search target information [second media type (e.g. image)] inhibited to be browsed [restricted out by the result viewing object 350 (See columns 9-12)] by the one of the users,

said searching unit searches for the search target information from the first type search target information contained in the plural pieces of search target information, and

said information search system further comprises... [See claim 4 above].

Claims 6 and 8 are rejected on the same basis as claim 1. See the discussion regarding claim 1 above for the details of this disclosure.

Claims 7 and 9 are rejected on the same basis as claim 2. See the discussion regarding claim 2 above for the details of this disclosure.

Claim 10 is rejected on the same basis as claim 3. See the discussion regarding claim 3 above for the details of this disclosure.

Claim 11 is rejected on the same basis as claim 1. See the discussion regarding claim 1 above for the details of this disclosure.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coden in view of Fleming as applied to claim 1 above, and further in view of U.S. Patent No. 5,946,678 to Aalbersberg (cited in non-final Office action of 27 February 2004).

Coden v. Fleming teaches an information search system, comprising:

an information storage unit...[See claim 1 above];

a searching unit [See claim 1 above] searching for information based on user specified search target information and maintaining a history of searches carried out by each user [See contribution of Fleming in combination of claim 1 above];

a calculating unit [See claim 1 above] calculating a synthetic fitting value [Coden: 'combined rank' for a document (See column 12, lines 26-35 and column 9, line 54 - column 10, line 23)] and a plurality of type-based fitting values [rank for each 'part' of a document (See column 12, lines 26-35 and column 9, line 54 - column 10, line 23)] for every item searched, using fitting value calculation procedures specified by the user; and



a search summary unit [See claim 1 above] presenting, for each search the search target information used, results generated by the search, and the synthetic fitting value calculated for each result.

Neither Coden nor Fleming discloses presenting (by the search summary unit) “a plurality of fitting values calculated for each result” as claimed. That is, Coden only presents one fitting value, the “synthetic fitting value”, along with the search results, but does not present the other fitting values for the individual parts of each document.

Aalbersberg discloses a system and method similar to those of Coden and Fleming, wherein a plurality of type-based fitting values are calculated [for each piece of search target information (i.e. ‘car’, ‘europe’ & ‘sales’)], a synthetic fitting value is calculated as a combination of the type-based fitting values [overall rank], and all of the above fitting values are presented along with the search target information used for each result [See Figs. 2-4 & corresponding portions of Aalbersberg’s specification]. Aalbersberg’s motivation for presenting all of the fitting values for each search result is to provide the user with additional information pertinent to how each piece of search target information (part of the query) individually contributes or relates to the overall ranking of each result. See the Background & Summary sections of Aalbersberg’s specification for this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Aalbersberg’s presentation of all fitting values, type-based and synthetic, into the combination of Coden and Fleming to obtain the invention as claimed. One would have been motivated to do so in order to provide the user with

additional information pertinent to how each piece of search target information (part of the query) individually contributes or relates to the overall ranking of each result, as disclosed by Aalbersberg.

### ***Response to Arguments***

5. Applicant's arguments filed 3 January 2005 have been fully considered but they are not persuasive.

Referring to applicants' remarks on page 9 regarding the Section 103 rejection of the independent claims: Applicants repeated arguments asserted in the After-Final submission of 1 December 2004, reasserting that, "the figures of Fleming III on which the Examiner relies to not illustrate information output by Fleming III."

The examiner disagrees for the following reasons: The portions of Fleming's disclosure cited by applicants are broad, introductory descriptions of Figures 9 and 10. The conclusion applicants have drawn from this piecemeal analysis (that Fleming does not 'output' the information in Figs. 9 & 10) is simply unfounded in these, or any other portions of Fleming's specification. Although Figs. 9 and 10 are directed to 'examples', these 'examples' clearly show display of the information therein. First, in Column 11, line 30 et seq. Fleming explicitly states that information shown in Fig. 9 is **displayed**. This explicit disclosure flies in the face of applicants' conclusion altogether. Second, even absent this disclosure by Fleming, one of ordinary skill in the art would clearly understand the information in Fleming's Figs. 9-10 to be displayed, or at least output in some manner, because this is the express purpose of Fleming's invention. Again, the

Art Unit: 2161

examiner reasserts the response to applicants' arguments in the advisory action of 14 December 2004.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 571-272-4020. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg  
15 March 2005

  
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